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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/444,120	11/19/1999	YOSHIHIKO SHIODA	019441.023	8235

7590 05/23/2003

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EXAMINER

GORDON, RAEANN

ART UNIT	PAPER NUMBER
3711	20

DATE MAILED: 05/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/444,120	SHIODA, YOSHIHIKO
	Examiner Raeann Gorden	Art Unit 3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 12 March 2003.

2a) This action is **FINAL**.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1,3,4,6-24,27 and 28 is/are pending in the application.

4a) Of the above claim(s) 3,4,6,11-17,24,27 and 28 is/are withdrawn from consideration.

5) Claim(s) 7-10 is/are allowed.

6) Claim(s) 1,18-20 and 23 is/are rejected.

7) Claim(s) 21 and 22 is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All b) Some \* c) None of:  
1. Certified copies of the priority documents have been received.  
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

<input type="checkbox"/> Notice of References Cited (PTO-892)	<input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ .
<input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	<input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
<input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.	<input type="checkbox"/> Other: _____

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 18, and 23 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Davis (3,168,312). Davis discloses a frame comprising a base, a vertical stand, a horizontal arm attached to the stand, a flexible cord attached to the horizontal arm, and a ball attached to the flexible cord adjacent the ground (see fig 1). Davis further discloses the device utilized for balls of differing weights and densities and may be struck with various types of striking implements (col 2, lines 1-5). Davis gives examples of softballs and baseballs as the type of larger ball that can be accommodated by the device (col 1, lines 65-70).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davis. Davis discloses the invention as shown above but fails to include the height of the frame. However, Davis discloses the device may be used for a variety of sports (col 2, lines 30-32). Davis gives examples of using softballs and baseballs. It is obvious the height of the frame would fall between 1 ½ and 5 feet to accommodate the heights associated with sports such as softball and baseball.

#### ***Allowable Subject Matter***

Claims 21 and 22 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 7-10 are allowed.

#### ***Response to Arguments***

Applicant comments with regards to the examining procedures during the prosecution of the present application have been noted. The Examiner apologizes for any inconvenience incurred by the applicant. However, prior art deemed applicable by the Examiner cannot be ignored during any part of the prosecution. In regards to the Davis reference, the rejection is maintained. The structural limitations claimed by applicant are clearly disclosed by Davis as shown above. Applicant argues the method of using the device is different from the method disclosed by Davis. For example, applicant states "while the Davis patent discloses that the retrieving device can be used

with various types of ball, it discloses that the ball is selected to practice the sport for which the ball is intended, i.e. a baseball for practicing baseball, a golf ball for practicing golf, a tennis ball for practicing tennis..... It does not teach or disclose utilizing a ball of a weight and size for one sport being used to practice another sport." The Examiner agrees with applicant's statement in regards to the prior art. However, applicant is not entitled to a patent for an apparatus with identical structural features as the prior art with a different method of use. The method of using an apparatus is not a patentable distinction. As shown above, the apparatus as claimed by applicant is identical to the apparatus disclosed by Davis. While the methods of using the apparatus may be different the structural features are the same.

### *Conclusion*

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

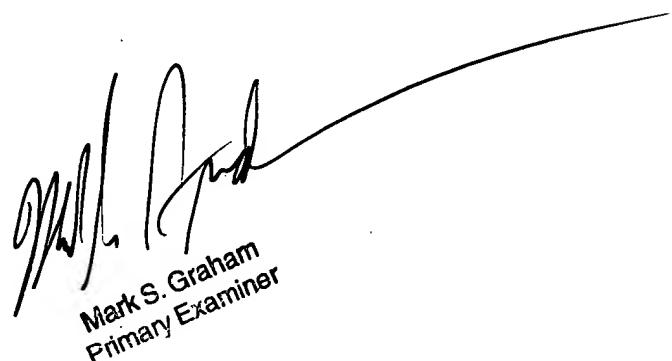
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raeann Gorden whose telephone number is 703-308-8354. The examiner can normally be reached on M-F 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Sewell can be reached on 703-308-2126. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

rg  
May 21, 2003



Mark S. Graham  
Primary Examiner

A handwritten signature in black ink, appearing to read "Mark S. Graham". Below the signature, the name "Mark S. Graham" is printed in a standard font, with "Primary Examiner" printed in a smaller font directly beneath it.